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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,210	08/03/2001	Sean Sanderlin	P-99996.886	7904

66558 7590 12/31/2007
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EXAMINER

VIG, NARESH

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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12/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/922,210	Applicant(s) SANDERLIN, SEAN	
	Examiner Naresh Vig	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 12, 13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) 15-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 and 12-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This is in reference to communication received 01 October 2007. Addition on new claims 15 – 23 is acknowledged. Claims 9, 12 – 13 and 15 – 23 are pending for examination.

Response to Arguments

Applicant's arguments and concerns are for amended claims which have been responded to in response to pending claims.

Claim Objections

Claim 10 is objected to because of the following informalities: Claim 23 claims dependency on claim 10. Claim 10 has been withdrawn. To further the prosecution of the application, examiner reads claim 23 as claiming dependency on claim 20. Appropriate correction is required.

Election/Restrictions

Newly submitted claims 15 - 23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons.

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- I. Claims 9 and 12 – 13 are directed to checking and clearing relationship problems in an organization by providing computer system connected to a plurality of computer terminals through a data transmission network; storing, upon said database, existing relationship data denoting one or more existing parties being serviced by said organization inputted by a member of the organization, said member being a requesting party; transmitting said potential relationship data from said database to substantially all of said member via said data transmission network; receiving, response information concerning said potential relationship data, said response information entered by any one or more of said members; transmitting said response information from said terminals to both of said requesting party and said conflicts administrator through said data transmission network; actuating said computer system to compare said potential relationship data and said existing relationship data to determine a degree of similarity therebetween; creating an electronic report which sets forth the results of the degree of similarity comparison and providing said requesting party with said report.
- II. claims 15 – 19 are directed to method for use by an organization of members in order to ascertain if a conflict exists between a potential new client matter and any pre-existing client matters of the organization by Soliciting members of the organization to submit new client requests in order to ascertain if the new client request conflicts with pre-existing client data of the organization; Receiving new

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client request submissions from said members; Compiling a multiplicity of said new client requests from said submissions in a computer database; Conducting a computerized word comparison between each new client request and pre-existing client data to determine a degree of similarity between each request and the pre-existing client data; Based on the degree of similarity between a request and the pre-existing client data, making a first determination as to whether a conflict exists; Contemporaneously with the computerized comparison, submitting the multiplicity of new client requests to a plurality of members of the organization via a computer interface; Based on the feedback from members, making a second determination as to whether a conflict exists between a new client request and pre-existing client data.

- III. claims 20 – 23 are directed to method for checking and clearing relationship problems in an organization by providing a computer system having a central database connected to a plurality of computer terminals; storing, upon said database, existing relationship data denoting one or more existing parties being serviced by said organization; conducting two separate but parallel conflict inquiries based on said potential relationship data, namely a first conflict inquiry and a second conflict inquiry, wherein said first inquiry comprises actuating said computer system to compare said potential relationship data and said existing relationship data to determine a degree of similarity therebetween; and creating an electronic report which sets forth the results of the degree of similarity

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comparison; and, wherein said second inquiry comprises: transmitting said potential relationship data from said database to substantially all of said members via said computer terminals; utilizing both the response information and the electronic report to determine if a relationship problem exists; Requesting party to affirm they have reviewed both the response information and the report; approving or disapproving a proposed relationship based at least in part on said requesting party's review of both the response information and the report.

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different functions and effect, Group I directing a conflict check and Group II soliciting members and compiling a multiplicity of new client requests, conducting a word comparison, and receiving feedback as a way of providing a conflict check.

Because these inventions are independent or distinct for the reasons given above and because the search required for Group I is not required for group II and because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claims 8-12 are withdrawn from consideration as being directed to a non-elected invention, see 37 CFR 1.142(b) and MPEP § 821.03.

Claim 23 claims dependency on claim 10. Claim 10 has been withdrawn. To further the prosecution of the application, examiner reads claim 23 as claiming dependency on claim 20. Appropriate correction is requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 12 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horwitz et al. US Patent 5,774,866 hereinafter known as Horwitz in view of Applicant's Admitted Prior Art hereinafter known as AAPA.

Regarding claims 9 and 12 - 14, as best understood by examiner, Horwitz teaches computerized method for checking and clearing relationship problems in an

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organization. As acknowledged by the applicant "U.S. Patent No. 5,774,866, the '866 patent, describes a computerized system used to determine if a conflict of interest exists" [instant application, 0007]. Horwitz in view of AAPA teaches capability for:

- providing a computer system having a central database connected to a plurality of computer terminals through a data transmission network to substantially all members;

- storing, upon database, existing relationship data denoting one or more existing parties being serviced by organization [Horwitz, Fig.1 and disclosure associated with Fig. 1];

- storing, upon database, potential relationship data denoting one or more potential parties, potential relationship data inputted into one of terminals by a member of the organization who can be a requesting party;

- transmitting potential relationship data from database to substantially all members terminals through data transmission network;

- displaying upon said terminals said transmitted potential relationship data for review by said members;

- providing a visual indication upon displaying terminals graphic user interface of members that new potential relationship data is available for review (providing an indication of pending status accessible through the network for each proposed matter) [Horwitz, col. 4, lines 40-46];

Horwitz does not explicitly teach displaying potential relationship data upon terminals for review by members. However, Horwitz teaches that Many law firms utilize computerized systems for the initial stages of a conflict checking process. AAPA

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teaches "Some law firms seek to avoid conflicts by circulating hard copy memoranda of potential new matters to all of their attorneys, so that each attorney can review all incoming clients and/or matters and voice any objections" [AAPA, 004]. It would have been obvious to one of ordinary skill in the art to modify Horwitz and electronically distribute memoranda of new matters to automate the content delivery. For example, distribution of documents in electronic format like MS-Work, PDF, email, broadcast etc. (In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958))

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify teachings of Horwitz as taught by AAPA a process commercially in use at the time of invention of circulating memoranda of potential new matters to all of their attorneys to comply to Conflict Of Interest Systems Conversion Manual published by Attorney's Liability Assurance Society, Inc. (1991).

Horwitz in view of AAPA teaches:

providing a graphic user interface upon each of said displaying terminals, said graphic user interface for facilitating communication between a member and said requesting party;

receiving, via said terminals, response information concerning said potential relationship data, said response information entered by any one or more of said members;

transmitting response information from terminals to both of requesting party and conflicts administrator through data transmission network;

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actuating computer system to compare potential relationship data and existing
Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810.
The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for
the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the
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USPTO Customer Service Representative or access to the automated information
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naresh Vig
Examiner
Art Unit 3629

December 26, 2007